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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,229	03/30/2004	Michael Frederick Kenrich	2222.5490000	8114
26111 7590 11/28/2007 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER ABEDIN, SHANTO	
			ART UNIT 2136	PAPER NUMBER
			MAIL DATE 11/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 10/815,229	<b>Applicant(s)</b> KENRICH ET AL.	
	<b>Examiner</b> Shanto M Z Abedin	<b>Art Unit</b> 2136	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 17 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***DETAILED ACTION***

1. This office action is in response to the communication filed on 09/17/2007.
2. Claims 1-25 are pending in the application.
3. Claims 1-25 are rejected.

***Information Disclosure Statement***

4. The information disclosure statement filed on 10/29/2007 fails to comply with 37 CFR 1.105 because it does not include a set of relevant prior arts to be considered by the examiner. The applicant and assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. The applicant and assignee of this application are suggested to provide the relevancy, or explanation of how the prior arts documents submitted in the information disclosure statement are relevant, or alternatively, at least to submit only the documents that are relevant to the application for consideration, and the examination purposes:

A preliminary consideration, and key-word search was conducted by the examiner, based on the first forty patents were submitted by the applicant. However, the search result shows no particular relevancy of these patents with the instant application, furthermore, submitted patents are from a broad range of USPTO class/ subclasses, and subject matter. Therefore, it is burdensome to the examiner to decide what exactly the scope or the invention, and conduct a meaningful search. Key words/ string used in examiner search was

“document or file or key”, “retention or retain\$4 or access”, “cryptographic\$4 or off\$line or cutt\$off”, “time or period or key”, “retention or retain\$4 or expir\$4 or access or hold”, “time or period”, etc. A copy of the search history is enclosed in the examiner’s search report.

For example, two slightly related submitted patents Preston et al (US 5052040) and Allen et al (US 4757533) talks about ‘retention’ or ‘retaining’ , however only in terms of system state (power up or not), or file state(encrypted or not) – no mention of off-line access control, or cut-off period for the retention key.

Therefore, the applicant and assignee of this application are suggested to provide the relevancy, or explanation of how the prior arts documents submitted in the information disclosure statement are necessary to be considered, or alternatively, at least to provide only the documents that are relevant to the instant application for proper examination purposes.

### *Response to Arguments*

5. Provisional Nonstatutory Double Patenting Rejections: The previous provisional nonstatutory double patenting rejection of claims 1-25 are maintained, however, these rejections are held in abeyance until the instant application or the copending application be in condition for allowance.
6. The applicant’s argument’s regarding the 35 USC 101 rejections of claims 1,3-6, 21 and 23-24 are fully considered and found persuasive, therefore, the previous 35 USC 101 rejections of claims 1,3-6, 21 and 23-24 are withdrawn.

7. The applicant's arguments regarding the 35 USC 102 (e) type rejections of claims 1-25 are fully considered, however, found not persuasive. Regarding the 35 USC 102 (e) type rejections of claims 1-25, the applicant primarily argues that cited reference Ryan fails to disclose generating or associating a policy or encryption key with a recurring cut off retention schedule or next cut-off period.

However, the examiner respectfully disagrees with the applicant since upon further examination, reference Ryan is found to teach a policy or encryption key that being associated with a recurring cut off retention schedule or next cut-off period (please see par [0015], [0037], [0051] to [0053]; expiring predetermined retention/ access time; (new) time based key; time based access/ restriction to document; the examiner interprets Ryan's above teachings of (a) time based access/ encryption key, and (b) time based access/ restriction/ policy for the document or file, at least teaches enablement of such policy or encryption key with a recurring cut off retention schedule or next cut-off period).

Furthermore, in response to the applicant's argument that Ryan teaches no "retention schedule" or "cut-off period", the examiner respectfully disagrees since Ryan's teachings of "time based access/ policy" or "time based (access) key" can be interpreted, or teaches enablement of "retention schedule" or "cut off period".

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-25 are rejected under 35 USC 102 (e) as being anticipated by Ryan (US 2005/ 0071657 A1).

***Regarding claim 1, Ryan discloses a method of providing automated document retention for an electronic document comprising:***

(a) assigning a document retention policy to the electronic document, the document retention policy being based on a recurring cut-off retention schedule (Par [0027],[0029], [0037], [0038];[0051]-[0053]; expiring predetermined retention/ access time; (new) time based key; time based access/ restriction to document; the examiner interprets Ryan's above teachings of (a) time based access/ encryption key, and (b) time based access/ restriction/ policy for the document or file, at least teaches enablement of such policy or encryption key with a recurring cut off retention schedule or next cut-off period); and

(b) cryptographically associating the document retention policy with the electronic document (Par [0027], [0029], [0037], [0038], [0051]; securing/ encrypting; time based access/ restriction/ policy for the document or file).

***Regarding claim 10, it is rejected applying as above rejecting claim 1, furthermore, Ryan discloses a method comprising:***

determining whether a cut-off period for a current or prior document retention key has been reached (Par [0027],[0029], [0037], [0038];[0051]-[0053]; time based access; expiring predetermined retention/ access time);

generating a next document retention key to be used to encrypt an electronic document during a next cut-off period, the next document retention key having a document retention period associated therewith (Fig 4, 5; Par [0037], [0038];[0051]-[0053]; new time based key; time based access to the document, and time based access key); and notifying a clients of the next document retention key ([0051]-[0053]).

***Regarding claim 13***, it is rejected applying as above rejecting claim 1, furthermore, Ryan discloses a method for restricting access to an electronic document, said method comprising:

encrypting the data portion of the electronic document using the document key to produce an encrypted data portion (Fig 4, 7; Par [0047]-[0051]; Claims 9-16; encrypting/securing the document);

using a retention access key to associate document retention policy on the electronic document (Par [0013], [0017], [0051]-[0053], [0065]; policy; new time based access key; expiring predetermined access);

encrypting the document key using the retention access key to produce an encrypted document key, the retention access key only being usable for said encrypting during a cut-off period of a recurring cut –off retention schedule(Par [0037]-[0038], [0047]-[0053];

Claims 9-16; expiring predetermined retention/ access time; new time based access key; the examiner interprets Ryan's above teachings of (a) time based access/ encryption key, and (b) time based access/ restriction/ policy for the document or file, at least teaches enablement of such policy or encryption key with a recurring cut off retention schedule or next cut-off period);

forming a secured electronic document from at least the encrypted data portion and the encrypted document key (Fig 4, 7; Par [0047]-[0051]-[0053]; Claims 9-16; encrypted or securing the document); and

storing the secured electronic document (Par [0047]-[0051]; Claims 9-16).

*Regarding claim 16*, it is rejected applying as above rejecting claim 1 and 13, furthermore, Ryan discloses a method for accessing a secured electronic document by a requestor, the secured electronic document having at least a header portion and a data portion, said method comprising:

obtaining a retention access key, the retention access key being used to associate a document retention period of a document retention policy on the electronic document, the retention access key being usable only during the document retention period following a cut-off period of a recurring cut off retention schedule(Par [0027],[0029], [0037], [0038];[0051]-[0053]; time based access; expiring predetermined retention/ access time);



obtaining an encrypted document key from the header portion of the secured electronic document (Fig 4, 7; Par [0047]-[0051]; Claims 9-16; encrypted or securing the document);

decrypting the encrypted document key using the retention access key to produce a document key (Par [0047]-[0052]; Claims 9-16; decrypted document);

decrypting an encrypted data portion of the secured electronic document using the document key to produce a data portion (Par [0047]-[0052]; Claims 9-16).

*Regarding claims 21 and 25*, they recite the limitations of claims 10 and 13-20, therefore, they are rejected applying the same rational as applied to reject claims 10,13-20.

*Regarding claim 2*, it is rejected applying as above rejecting claim 1, furthermore, Ryan discloses the method further comprising:

© cryptographically preventing access to the electronic document in accordance with the document retention policy when the document retention period for the electronic document has been exceeded (Par [0016], [0038];[0051]-[0053]; Claims 13-18; exceeding/ expiring predetermined time; time based policy/ access).

*Regarding claim 3*, it is rejected applying as above rejecting claim 1, furthermore, Ryan discloses wherein step (b) utilizes a cryptographic key to impose the document retention policy, and wherein the document retention policy specifies a document retention

period and a cut-off period (Par [0027], [0037], [0038], [0045], [0051]-[0053]; time based access to the document and key; expiring predetermined retention/ access time).

*Regarding claim 4, Ryan discloses a method as recited in claim 3, wherein the document retention policy specifies a document retention period that expires a predetermined period of time after the cut-off period (Par [0029], [0037], [0038];[0051]-[0053], [0065]).*

*Regarding claim 5, Ryan discloses a method as recited in claim 3, wherein the cut-off period corresponds to a maximum off-line period of a client ([0037], [0038];[0051]-[0053]).*

*Regarding claim 6, Ryan discloses a method as recited in claim 1, wherein said imposing comprises acquiring a cryptographic key from a server over a network, the cryptographic key being used to associate the document retention policy (Par [0013], [0017], [0051], [0065]; policy; access key).*

*Regarding claim 7, it is rejected applying as above rejecting claim 1 and 6, furthermore, Ryan discloses a method as recited in claim 6, wherein said method further comprises:*

© deactivating the cryptographic key when a document retention period has expired, thereby preventing further access to the electronic document (Par [0017], [0046], [0051]; Claims 18-23; time based access key; expiring predetermined retention/ access time).

***Regarding claim 8, Ryan*** discloses a method as recited in claim 7, wherein said imposing operates to utilize a cryptographic key to impose the document retention policy, and wherein the document retention policy specifies a document retention period and a cut-off period (Par [0037], [0045], [0051],[0057], [0060], [0062], [0065]; access restriction to the document and key).

***Regarding claim 17, Ryan*** discloses a method as recited in claim 16, wherein the retention access key is identified by an indicator within a header portion of the secured electronic document (Fig 7; header; file key; Par [0047]-[0053]; Claim 1-16).

***Regarding claim 18, Ryan*** discloses a method as recited in claim 16, wherein the retention access key is a private retention access key (Fig 7; header; file key; Par [0047]-[0053]; Claim 1-16; private/ public key pair).

***Regarding claims 9, 11-12,*** they recite the limitations of claims 4-8, therefore, they are rejected applying as above rejecting claims 4-8.

***Regarding claims 14-15 and 19-20,*** they recite the limitations of claims 4-6 and 17-18, therefore, they are rejected applying as above rejecting claims 4-6 and 17-18.

***Regarding claims 22-24,*** they recite the limitations of claims 2-9, therefore, they are rejected applying as above rejecting claims 2-9.

***Conclusion***

9. A shortened statutory period for response to this action is set to expire in 3 (Three) months and 0 (Zero) days from the mailing date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C 133, M.P.E.P 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanto M Z Abedin whose telephone number is 571-272-3551. The examiner can normally be reached on M-F from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser, can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shanto M Z Abedin

Examiner, AU 2136

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11/27/07